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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,346	08/15/2000	Danny Leroy Fleming	55680USA9A.002	2529

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EXAMINER

EGAN, BRIAN P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MFE 4

**Office Action Summary**

Application No.

09/638,346

Applicant(s)

FLEMING ET AL.

Examiner

Brian P. Egan

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8-15-2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because they are faded and unable to be read. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-6, and 12-13 are rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The phrases “substantially continuous,” “substantially regular,” “substantially trapezoidal,” and “substantially flat top” are unclear. It is unclear how substantial “substantial” is intended to be by the applicant’s. Proper clarification and/or correction is required.
4. Claim 17 is rejected under 35 U.S.C. 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The phrase, “the film layer is imaged on a surface” is unclear. It is unclear what the applicant intends “imaged” to mean. Proper clarification and/or correction are required.

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5. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, for failing to enable any person skilled in the art to which the application pertains to make and use the same. It is unclear what is meant by a "handling film." Both the claims and the specification fail to adequately define what a "handling film" refers to (other than the fact that it is component #140 in Fig. 4). It is well known in the art that most adhesive backed articles wherein an adhesive is adhered to a substrate is "handle-able" and the substrate would therefore constitute a "handling film." Therefore, a "handling film" has been defined in its broadest possible sense for examination purposes. Proper clarification and/or correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-6 and 8-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Calhoun et al. (#5,462,765).

Calhoun et al. ('765) disclose a release liner (Fig. 2) for an adhesive backed article (Col. 1, lines 11-16) comprising a surface with an arrangement of structures thereon, wherein the structures are ridges that extend upward from a plane of the surface (Fig. 2), and wherein the structures have at least one sidewall that makes an angle with respect to the plane of the surface of greater than zero degrees and less than ninety degrees selected to enhance adhesion to a tape (Col. 4, lines 57-62). The angle can be further limited between thirty and fifty degrees (Col. 6, lines 26-28). The ridges form a regular and continuous pattern on the surface (Fig. 2; Col. 4, lines 66-67). The ridges have a trapezoidal cross-sectional shape with a flat top (Fig. 2). The ridges have a pitch from 50-250 $\mu$ m (Col. 5, lines 57-61) (thereby falling within the range of 150-1300 $\mu$ m). The adhesive backed article further comprises an imaged film layer on a surface opposite the adhesive layer (Col. 8, lines 33-36).

8. Claims 1-6 and 8-17 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/311,101 to Mikami et al. filed May 13, 1999, which has a common assignee with the instant application.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application.

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Mikami et al. disclose a release liner for an adhesive backed article comprising a surface with an arrangement of structures thereon (p.7, lines 15-18), wherein the structures are ridges that extend upward from a plane of the surface (see Fig. 1), and wherein the structures have at least one sidewall that makes an angle with respect to the plane of the surface from 0-90 degrees (p.13, lines 26-27). The ridges form a regular and continuous pattern on the surface (see Fig. 1; p.12, lines 19-21). The ridges have a trapezoidal cross-sectional shape with a flat top (see Fig. 1; p.11, lines 12-14). These ridges have a pitch of less than 400µm (p.12, lines 19-26). The adhesive backed article further comprises an imaged film layer on a surface opposite the adhesive layer (p.8, lines 4-11).

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (#5,897,930).

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Calhoun et al. ('930) teach a release liner (see Abstract) for an adhesive backed article comprising a surface with an arrangement of ridged, substantially trapezoidal structures thereon (Figs. 1-2; Col. 6, line 30), wherein the structures extend upward from a plane of the surface (Figs. 1-2). The adhesive backed article comprises an imaged film layer on the surface opposite the release liner (Col. 1, lines 15-31). Although Calhoun et al. ('930) do not explicitly state the angles of the sidewalls, Calhoun et al. ('930) state that "the sidewalls of embossings for any of pattern 24, pattern 26, or any combination of them, can be any shape desired, ranging from a constant radius of curvature to any polygonal shape of at least 2 surfaces within the pattern 24 or 26. Nonlimiting examples of shapes of embossing, in cross-section, include curved, rectangular, trapezoidal, triangular, bimodal, and the like (Col. 6, lines 25-31)." Note that the aforementioned quote would allow the release liner to be formed with overlapping ridges depending on the desired end product. Therefore, it would have been an obvious matter of design choice to one of ordinary skill in the art at the time applicant's invention was made to have modified the release liner to have sidewalls ranging in angles from 0-90 degrees and to have overlapping ridges based on the desired end product as taught by Calhoun et al. ('930) above. Calhoun et al. ('930) further teach that the pitch of the embossings is less than 200 $\mu$ m (Col. 6, lines 43-47) and also give an example wherein a .25mm diameter embosser is used to place 190 posts per square centimeter in a square lattice pattern (Col. 7, lines 46-50) thereby falling within the applicant's claimed limitation of 150-1300 $\mu$ m.

11. Claim 7 is provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 09/311,101 which has a common assignee with the instant application in view of Mazurek et al. (#5,650,215). Based upon the earlier effective U.S. filing

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date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

Mikami et al. teach a release liner for an adhesive backed article as described above.

Mikami et al. are silent in relation to Claim 7 – a release liner wherein the ridges are overlapping.

Mikami et al. state, however, that “it is possible to afford structures to the release liner by using various techniques, such as those disclosed in U.S. Patent No. 5,650,215 (Mazurek), herein incorporated by reference in its entirety (p.14, lines 20-24).”

Mazurek et al. teach an overlapping ridge structure as one of the “techniques” detailed by Mikami et al. (see Figs. 7-8). Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant’s invention was made to have modified Mikami et al. by using the techniques taught by Mazurek et al. in order to have an overlapping ridge structure for a release liner such that the release liner would be matched with an adhesive layer with a similar structure.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention “by another,” or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2).



12. Claims 1-6 and 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe (WO 99/35201).

Abe teaches a release liner for an adhesive backed article comprising a surface with an arrangement of structures thereon, wherein the structures extend upward from a plane of the surface. The structures are trapezoidal ridges that form a continuous and regular pattern wherein the ridges have a pitch between 50 and 1000 $\mu$ m. The adhesive article further comprises an imaged film layer on a surface of the adhesive opposite the release liner. Although Abe is silent in relation to the angle of the sidewalls of the release liner, it is notoriously well known that a trapezoid is a “quadrilateral with two parallel sides (*Webster’s II New Riverside University Dictionary*, The Riverside Publishing Company: Boston, MA. 1984).” Abe teaches that, “the depressed portion surrounded by the projections had the trapezoidal section in the vertical direction (p.13, lines 22-23).” Therefore, one of ordinary skill in the art would recognize that the top and bottom surfaces of the trapezoidal projection are parallel and the side walls form the angles of the trapezoid. Thus, even if one of the side walls is set at a 90 degree angle, the other side wall cannot be 90 degrees or it would be parallel with the other sidewall and a square or rectangle would be formed rather than a trapezoid. Given that the structures project into the grooves of the adhesive layer (p.13, lines 18-20), the angles formed must be 90 degrees or less, because it would be impossible to match the projection with the groove if the top portion of the projection were wider than the base (since it would be impossible to force the top portion through an opening the size of the narrow base). Therefore, at least one of the sidewalls has an angle from 0-90 degrees. Given that the angle can fall anywhere within this range, the further limitation of an angle between 30 and 50 degrees is also met (unfortunately, Abe (Wo 99/35201)

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is not provided with any figures depicting the claimed structure to help in simplifying the aforementioned analysis). Furthermore, even if the side walls were to be the parallel sides, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the projecting structures such that the side walls were the non-parallel sides of the parallelogram thereby making at least one side wall with an angle of less than 90 degrees (based on the above analysis) for the purpose of providing a structure that can match with the groove of an alternate embodiment of the adhesive layer. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
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May 19, 2002